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FEB 02 2009

OFFICE OF PETITIONS

In re Application of :
SAKAI et al. : LETTER REGARDING PATENT
Application No. 10/651,038 : TERM ADJUSTMENT
Filed: 08/29/2003 :
Attorney Docket No. 086142-0575 :

This letter is in response to the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT," filed May 19, 2008. Pursuant to applicants' duty of good faith and candor to the Office, applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the determination of patent term adjustment is GRANTED to the extent indicate herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **254 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 29, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 283 days. On May 19, 2008, applicants submitted the instant comment.

Applicants state that the determination of patent term adjustment of 283 days, as indicated in the notice of allowance, disagrees with their calculation of 202 days of patent term adjustment. Therefore, applicants request a review of the calculation of patent term adjustment for the above-identified application.

A review of the application history confirms that the entry of a period of adjustment of 29 days pursuant to 37 CFR 1.703(a)(4) is incorrect.

Pursuant to 37 CFR 1.702(a), failure of the Office to respond to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken is a ground for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999. The phrase the date on which "an appeal was taken" in 35 U.S.C. 154(b)(i)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 37 CFR 1.192" requires that: (i) the appeal brief fee (37 CFR 1.17(c)) be paid (37 CFR 1.192(a)); and (2) the appeal brief complies with 37 CFR 1.192(c)(i) through (c)(9). Accordingly, 37 CFR 1.703(a)(4) pertains to the provisions of 35 U.S.C. 154(b)(i)(A)(ii) and specifies that the period of adjustment for Office delay includes the number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was filed and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

In this instance, an appeal brief was filed on August 14, 2006. On September 5, 2006, a notification of non-compliant appeal brief was mailed, stating that the brief was defective for failure to comply with one or more provisions of 37 CFR 41.37. On October 5, 2006, a corrected appeal brief was filed. On January 12, 2007, an examiner's answer under § 1.193 was mailed within four (4) months of October 5, 2006, the date the appeal brief in compliance with 37 CFR 1.192 was filed. Accordingly, there was no basis for entry of a period of adjustment for Office delay. The period of adjustment of 29 days is being removed.

Further, it is noted that the filing of the defective appeal brief on August 14, 2006, is not an action that constitutes a failure to engage in reasonable efforts to conclude prosecution of the application within the meaning of 37 CFR 1.704(c)(7).

37 CFR 1.704(c)(7) specifies the submission of a reply having an omission (§ 1.135(c)) is a circumstance that constitutes a

failure of the applicant to engaged in reasonable efforts to conclude processing or examination of an application resulting in a reduction of the period of adjustment by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The Office notes that 37 CFR 1.704(c)(7) only applies to the submission of a reply having an omission. As an appeal brief is not a reply, no reduction under 37 CFR 1.704(c)(7) is warranted.


In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **254 days (283 days of Office delay - 29 days of applicant delay)**.

As this letter was submitted as an advisement to the Office of an error in applicants' favor, the Office will not assess the \$200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Wednesday

PALM INTRANET

Date: 1/28/2009

Time: 17:36:34

PTA Calculations for Application: 10/651038

Application Filing Date:	08/29/2003	PTO Delay (PTO):	312
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	29
Post-Issue Petitions:	0	Total PTA (days):	254
PTO Delay Adjustment:	-29		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
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57	02/28/2008	DOCUMENT VERIFICATION			
56	02/28/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
55	02/28/2008	CASE DOCKETED TO EXAMINER IN GAU			
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53	02/14/2008	ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER			
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51	02/07/2008	ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER			
50	02/07/2008	ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER			
49	01/24/2008	APPEAL AWAITING BPAI DOCKETING			
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44	03/19/2007	EXAM. ANS. REVIEW COMPLETE			
43	03/19/2007	APPEAL BRIEF REVIEW COMPLETE			
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40	10/25/2006	DATE FORWARDED TO EXAMINER			
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38	09/05/2006	NOTICE -- DEFECTIVE APPEAL BRIEF			
37	09/01/2006	APPEAL BRIEF REVIEW COMPLETE			
36	09/01/2006	DATE FORWARDED TO EXAMINER			

35.1	08/14/2006	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
35	08/14/2006	APPEAL BRIEF FILED			
34	08/14/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
33	06/02/2006	MAIL APPEALS CONF. PROCEED TO BPAI			
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29	05/12/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
28	04/10/2006	MAIL ADVISORY ACTION (PTOL - 303)			
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25	03/27/2006	AMENDMENT AFTER FINAL REJECTION			
24	01/13/2006	MAIL FINAL REJECTION (PTOL - 326)			
23	01/09/2006	FINAL REJECTION			
22	03/24/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
21	08/29/2003	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
20	11/03/2005	DATE FORWARDED TO EXAMINER			
19	10/28/2005	RESPONSE AFTER NON-FINAL ACTION			
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16	07/27/2005	CASE DOCKETED TO EXAMINER IN GAU			
15	05/17/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
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13	08/29/2003	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
12.7	03/24/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	03/24/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	08/29/2003	REFERENCE CAPTURE ON IDS			
10.7	08/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

10	08/29/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	11/19/2003	APPLICATION RETURN FROM OIPE			
8	11/19/2003	APPLICATION RETURN TO OIPE			
7	11/20/2003	APPLICATION IS NOW COMPLETE			
6	11/19/2003	APPLICATION DISPATCHED FROM OIPE			
5	11/20/2003	APPLICATION IS NOW COMPLETE			
4	11/14/2003	CASE CLASSIFIED BY OIPE			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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